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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,411	11/28/2003	Armando Marcotullio	245946US0CONT	7408

22850 7590 12/21/2004

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EXAMINER

GRIFFIN, WALTER DEAN

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/722,411	Applicant(s) MARCOTULLIO ET AL.	
	Examiner Walter D. Griffin	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,9-11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,9-11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

The objections to the disclosure and to claim 11 are withdrawn in view of the amendment filed on October 14, 2004.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6, 9-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Di Lullo et al. (US 5,445,179) in view of Ohzeki et al. (US 4,565,546).

The Di Lullo reference discloses a process for recovering and causing highly viscous petroleum products to flow by forming aqueous dispersions wherein the water content of said dispersions is at least 15%. The ratio of the petroleum product to water by weight ranges from 90:10 to 10:90. Examples of the highly viscous petroleum products include atmospheric and vacuum residues. The process comprises bringing the heated petroleum product into contact with a dispersing agent to form the dispersion and then causing the dispersion to flow. The heat is such as to flux the petroleum product. This discloses heating to make the petroleum flow which would necessarily mean that the petroleum is heated to a temperature above its softening point. The dispersing agent is an ammonium salt or a salt of an alkali metal such as sodium of condensates of naphthalene sulfonic acid with formaldehyde. The amount of dispersant ranges from 0.2 to 2.5% based on the total amount of water and petroleum product. See col. 1, lines 7-9; col. 2, lines 10-55; col. 5, lines 49-68; col. 6, lines 1-9; col. 7, lines 1-7; and claims 1-3 and 6.

The Di Lullo reference does not disclose the use of a visbreaking tar or the tar characteristics of claims 15-17.

The Ohzeki reference discloses that dispersants similar to those used in the process of Di Lullo can be used to disperse petroleum products such as residues from products of a thermal cracking treatment of petroleum fractions. See col. 5, lines 43-68.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Di Lullo by utilizing a visbreaking tar such as those claimed including those having the characteristics as in claims 14-17 because such a tar

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would be expected to be effectively treated since the Ohzeki reference discloses that such tars (i.e., residues from thermal cracking processes) are dispersed by dispersants similar to those disclosed by Di Lullo. Regarding specific chemical and physical characteristics of the tar, any tar that falls in the broad class of products disclosed by both Di Lullo and Ohzeki would be expected to be effectively treated.

Also, while the Di Lullo reference does not explicitly disclose water contents of greater than 25 weight percent, it would have been obvious to one having ordinary skill in the art to utilize water contents within this claimed range because the range disclosed by Di Lullo encompasses the claimed range. Therefore, dispersions with the claimed amount of water would be expected to be effective in the Di Lullo process.

Response to Arguments

The argument that the visbreaking tars of the claimed process distinguish over the applied prior art is not persuasive because the Ohzeki reference is relied upon to show that the claimed tars can be dispersed with dispersants. Therefore, the examiner maintains that one of ordinary skill in the art would expect the claimed tars to be effectively dispersed in the process of Di Lullo.

The argument in the response and in the declaration filed on November 16, 2004 that the claimed process provides superior stability of the dispersions is not persuasive. The evidence upon which this argument is based does not appear to be commensurate in scope with the claims since claim 6 includes a water content range of greater than 25% by weight whereas the evidence

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is limited to only two values at the lower end of this range. Additionally, the claims are not limited to 0.50 weight percent of the dispersing agent.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

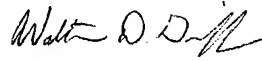
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter D. Griffin whose telephone number is (571) 272-1447. The examiner can normally be reached on Monday-Friday 6:30 to 4:00 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Walter D. Griffin
Primary Examiner
Art Unit 1764

WG
December 14, 2004